

## **REMARKS**

### **A. The claims as amended do not constitute double patenting.**

Claims 1-10 stand rejected under 35 U.S.C. §101 grounds as constituting double patenting over the claims of parent application 09/993,974, now U.S. patent no. 6,664,257 (“the ‘257 patent”). Applicants respectfully traverse.

Regarding pending claim 1, the substituent moieties R<sub>1</sub> and R<sub>2</sub> are defined in the claim as being:

each independently be lower cycloalkyl, bridgehead cycloalkyl, – or O- cyclized bridgehead cycloalkyl, cycloalkoxy, C<sub>1</sub> to C<sub>10</sub> alkenyl comprising 1 to 3 alkenyl moieties (C=C), fatty acids, aryl or substituted aryl, benzyl or C<sub>1</sub> to C<sub>10</sub> arylalkyl or substituted arylalkyl, heterocyclic aryl or arylalkyl, naphthyl, alkylamino, or halogenated derivatives thereof.

In contrast, in claim 1 of the ‘257 patent the substituent moieties R<sub>1</sub> and R<sub>2</sub> are defined in the claim as being:

each independently be H, lower alkyl (C<sub>1</sub> to C<sub>10</sub>), alkoxy, lower alkyl carboxy, β-lactam, or D- or L-amino acids, or di- or tripeptides, provided that at least one of R<sub>1</sub> and R<sub>2</sub> are not H.

Applicants respectfully submit that pending claim 1, reciting chemically-distinct substituent moieties, is not the same invention as claims in claim 1 of the ‘257 patent, and request that this ground of rejection be withdrawn with respect to pending claim 1.

Claims 2 through 6 have been amended to recite certain of the substituent groups recited in claim 1. None of the species recited in claims 2 through 6 are recited in any of the claims of the ‘257 patent, and thus Applicants respectfully submit that these claims do not encompass the same invention claimed in any of the claims of the ‘257 patent. Applicants thus ask that rejection of these claims be withdrawn.

Claims 7-10, reciting pharmaceutical compositions of the compounds claimed in claims 1 through 6, and methods for using said compounds and pharmaceutical compositions, are likewise not encompassed by any of the claims of the ‘257 patent, since the compounds of claims 1 through 6 are uniquely in the pending claims. Applicants thus respectfully contend that these claims do not encompass the same invention claimed in any of the claims of the ‘257 patent, and that rejection of these claims be withdrawn.

## CONCLUSION

It is believed that all requirements of patentability are fully met, and that the claims are free of the prior art. Allowance of the claims is thereby respectfully solicited.

If the Examiner in charge of this application believes it to be helpful, he is invited to contact the undersigned attorney by telephone at (312) 913-0001.

Respectfully submitted,  
**McDonnell Boehnen Hulbert & Berghoff**  
By: \_\_\_\_\_  
Kevin E. Noonan, Ph.D.  
Reg. No. 35,303

Dated: August 13, 2004